

Drawing Amendments

A replacement sheet for FIG. 5 is attached in an Appendix following page 14 of this paper.

Remarks

Claims 26 and 31 are amended. No new subject matter is added. Claims 1-11, 13-36, and 38-42 remain pending. Reconsideration and allowance of the pending claims is requested in light of the amendments and the following remarks.

Allowable Subject Matter

Claims 1, 5, 15, 21, 26, 31, 35, and 36 are indicated to be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph.

Drawing Objections

The drawings are objected to because in Fig. 5 because the arrow that corresponds to "RELEASE COMPLETE (busy)" should be pointing from User B's Endpoint to Gatekeeper/Proxy, and the arrow that corresponds to the second "SETUP (delay ringing until explicit notification)" should be pointing from Gatekeeper/Proxy to User B's Endpoint. The appropriate amendments are made in a replacement sheet for Fig. 5 that is attached following page 14 of this paper.

Claim Objections

Claims 26 and 31 are objected to because in line 2, "the computer" should be changed to "a computer." Accordingly, claims 26 and 31 are amended to remove this objection.

Claim Rejections, 35 U.S.C. 112, second paragraph

Claims 1-11, 13-36, and 38-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant respectfully disagrees.

The focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. MPEP 2173.02. The definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing

the ordinary level of skill in the pertinent art at the time the invention was made. MPEP 2173.02. Furthermore, the test for definiteness under 35 U.S.C. 112, second paragraph, is whether “those skilled in the art would understand what is claimed *when the claim is read in light of the specification.*” MPEP 2173.02, *citing* Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986), *emphasis added*.

In alleging the current rejection of claim 1 under 35 U.S.C. 112, second paragraph, the OA states “the claim as amended includes a delay point that indicates *both* call completion on busy *and* call completion on no answer.” The applicant disagrees, claim 1 actually recites “the *delay point indicating call supplementary services, the call supplementary services including call completion on busy and call completion on no answer*” (*emphasis added*).

The applicant has provided an explicit definition for delay point at page 6, lines 16-23. The applicant also explained what supplementary services are and how they are linked to delayed call establishment exchanges at page 5, lines 10-15. The applicant has further explained how the delay point is useful for delayed call establishment processes at, e.g., page 6, line 16 to page 7, line 5. In light of these disclosures, the applicant submits that those skilled in the art would understand what is claimed.

Further regarding claim 1, the OA states that “within the same call, the connection to the called party is either busy or no answer.” The applicant responds by pointing out that claim 1 is directed at a network device, not a method. The idea that a network device may be capable of performing multiple functions, but not necessarily at the same time, would be understood by those skilled in the art.

Furthermore, claim 1 recites “a processor to: send a call request message associated with a call to the called endpoint, the call request message including a delayed call establishment capability advertisement, and indicate a desire to delay call establishment until a delay point is reached, the delay point indicating call supplementary services.” Presumably, when the processor sends a call request message and indicates a desire to delay call establishment, the processor has no prior knowledge of how the called endpoint will respond, either with a busy signal or no answer. Therefore the idea of a delay point indicating call supplementary services, where call supplementary services includes both call completion on busy and call completion on no answer, is also understandable to those of skill in the art.

For the reasons outlined above, the applicant requests that the rejection of claim 1 and its dependencies (claims 2-4) under 35 U.S.C. 112, second paragraph, be withdrawn.

Independent claim 5 recites “the delay point indicating feature discovery of the called endpoint, the delay point further indicating call supplementary services.” Independent claims 15, 21, 26, 31, 35, 36 and 42 recite similar features.

The primary reason advanced by the OA for rejecting these claims under 35 U.S.C. 112, second paragraph, is that “the delay point indicating feature discovery of the called endpoint” and “the delay point further indicating call supplementary services” as recited in claim 5 and similarly in the other independent claims allegedly refer to mutually exclusive embodiments.

Several rationales are advanced for the proposition that these features of the independent claims are mutually exclusive. The first rationale is that the delay point for the embodiment of FIG. 4 is “when bidirectional media” is established, while the delay point for FIG. 5 “is identified as explicit notification.” However, the applicant has also explained in the specification how in some instances the delay point may be the point at which multiple conditions are satisfied. See page 7, line 15 to page 8, line 7.

The second rationale advanced appears to be that feature discovery of the called endpoint must be initiated by the calling endpoint, while supplementary services is initiated by an intermediary, not a calling endpoint. The OA at page 4 equates the embodiment of FIG. 4 as corresponding to the recited “feature discovery of the called endpoint.”

But according to the applicant’s specification – “Figure 4 shows a call flow for continuity, QoS, or other testing. In Figure 4, the testing device transmits a setup message with the delay point being reached when bi-directional media is established. The term endpoint was used above, and *it must be noted that the calling entity may not be an actual endpoint, such as a user’s phone. It may be a network intermediary that initiates testing, but that will act as the calling endpoint in this type of situation*” (page 10, lines 2-7; emphasis added). Therefore the applicant disagrees that the embodiment that the OA equates to “feature discovery of the called endpoint” must be initiated by the calling endpoint.

For the reasons outlined above, the applicant requests that the rejection of independent claims 5, 15, 21, 26, 31, 35, and 36 and under 35 U.S.C. 112, second paragraph, be withdrawn.

Regarding claim 38 and 40, the claims recite “the delay point indicates diagnostic testing without alerting a user of the called endpoint.” As was explained above for claim 5, the embodiments of FIG. 4 and FIG. 5 are not mutually exclusive, and the delay point may be indicative of more than one condition having been fulfilled. For at least these reasons, the applicant requests that the rejection of dependent claims 38 and 40 under 35 U.S.C. 112, second paragraph, be withdrawn.

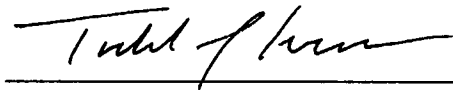
Regarding claim 42, the claim recites “wherein the call supplementary services include call completion on busy and call completion on no answer.” This feature was addressed above in the discussion of claim 1, and for the same reasons the applicant requests that the rejection of dependent claim 42 under 35 U.S.C. 112, second paragraph, be withdrawn.

Conclusion

For the foregoing reasons, reconsideration and allowance of the pending claims is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in black ink, appearing to read "Todd J. Iverson", is written over a horizontal line.

Todd J. Iverson
Reg. No. 53,057

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613
Customer No. 20575